

07



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/808,133 | 03/15/2001 | Keisuke Iwai | P 279078 | 4613 |

909 7590 03/18/2005
PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

LAYE, JADE O

ART UNIT PAPER NUMBER

2614

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,133

Applicant(s)

IWAi

Examiner

Jade O. Laye

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/5/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 3/15/01, 9/15/03 and 11/5/04 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statements.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 1-3, 5-9, 12, 13, 16-20, 23, and 24 are rejected under 35 U.S.C. 102(a) as being anticipated by Inagaki et al. (JP2000-13707).

As to claim 1, Inagaki discloses a program reservation system in which the system receiver and reservation terminal each contain a slot for a removable storage medium, wherein a removable storage medium can be used to store reservation information and EPG data. Therefore, a user can reserve a program on the reservation terminal, which is stored on the removable medium, then transfer the storage medium to the receiver and retrieve the requested program. (Par. [0005, 0011, 0014, 0036]). Accordingly, Inagaki et al anticipate each and every limitation of claim 1.

Claims 12 and 23 are encompassed by the limitations of claim 1. Therefore, they are analyzed and rejected as previously discussed.

As to claim 2, Inagaki teaches the system receiver is capable of acquiring and storing EPG data (Par. [0014]) and contains a means for storing said EPG data in the removable storage medium. (Par. [0036]). In addition, Inagaki's reservation terminal is capable of displaying EPG data retrieved from the storage medium located in the reservation terminals slot. (Par. [0036]). Although Inagaki does not expressly teach a means for determining whether the reservation terminal's removable medium contains EPG data, this would be inherent, and is therefore encompassed in Inagaki's system. In order for the reservation terminal to perform its function (e.g., displaying/reserving EPG data), it must have a means of detecting whether an EPG is present on the storage medium. Accordingly, Inagaki et al anticipate each and every limitation of claim 2.

As to claim 3, Inagaki further teaches the receiver contains a means for acquiring and storing EPG data based upon a first and second information element (i.e., program descriptions) and the program reservation terminal is capable of reserving the programs based upon said first and second information elements. (Par. [0005 & 0036]). Accordingly, Inagaki et al anticipate each and every limitation of claim 3.

As to claim 5, Inagaki further teaches the program reservation terminal contains a slot for the removable medium and can read/store EPG data from the removable storage medium. (Par. [0036]). Accordingly, Inagaki et al anticipate each and every limitation of claim 5.

Claim 16 corresponds to the means plus function claim 5. Thus, it is analyzed and rejected as previously discussed.

As to claim 6, Inagaki further teaches the program reservation terminal contains a display for reading and displaying EPG data. (Par. [0036]). Although Inagaki does not expressly teach a means for determining whether the reservation terminal's removable medium contains EPG data, this would be inherent, and is therefore encompassed in Inagaki's system. In order for the reservation terminal to perform its function (e.g., displaying/reserving EPG data), it must have a means of detecting whether an EPG is present on the storage medium. Accordingly, Inagaki et al anticipate each and every limitation of claim 6.

Claim 17 corresponds to the means plus function claim 6. Thus, it is analyzed and rejected as previously discussed.

As to claim 7, it is inherent from the disclosure of Par. [0036], Inagaki's system is capable of identifying information entered by the user. Accordingly, Inagaki et al anticipate each and every limitation of claim 7.

Claim 18 corresponds to the means plus function claim 7. Thus, it is analyzed and rejected as previously discussed.

As to claim 8, Inagaki further teaches his program reservation terminal is capable of transmitting/receiving EPG related information to/from a communication apparatus and is capable of displaying said EPG data on a display screen. (Par. [0015 & 0036]). Accordingly, Inagaki et al anticipate each and every limitation of claim 8.

Claim 19 corresponds to the means plus function claim 8. Thus, it is analyzed and rejected as previously discussed.

As to claim 9, Inagaki teaches the program reservation terminal is capable of receiving a simplified program guide. (Par. [0018]). Accordingly, Inagaki et al anticipate each and every limitation of claim 9.

Claim 20 corresponds to the means plus function claim 9. Thus, it is analyzed and rejected as previously discussed.

As to claim 13, Inagaki's receiver is inherently capable of comparing reservation data read from the storage medium with EPG data in the receiver's memory and setting the receiver to received said reserved programs. (Inherent from disclosure of Par. [0036]). Accordingly, Inagaki et al anticipate each and every limitation of claim 13.

Claim 24 corresponds to the means plus function claim 13. Thus, it is analyzed and rejected as previously discussed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims 4, 11, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (JP2000-13707).

Claim 4 recites limitations which are too numerous to list herein. However, claim 4 recites the same limitations of claim 1, except claim 4 contains an additional limitation directing the system to mobile communications. The examiner takes Official Notice that mobile communication systems were well known in the art at the time of applicant's invention. Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine Inagaki's system with the well known art of mobile communications in order to provide the system of Inagaki in mobile vehicles, planes, etc.

Claims 11 and 22 correspond to the means plus function claim 4. Accordingly, each is analyzed and rejected as previously discussed.

3. Claims 10, 15, 21, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki '707 in view of Inagaki et al. (JP2000-13697).

Claim 10 recites limitations too numerous to list herein. Claim 10 recites limitations encompass under claim 1, and adds an additional limitation directed to a conversion means. As for those limitations encompassed under claim 1, Inagaki '707 Par. [0036] anticipates each and every limitation as discussed under the rejection of claim 1. But, Inagaki '707 fails to specifically teach any conversion means used to convert reservation data into a format compatible with EPG the information. However, within the same field of endeavor, Inagaki '697

Art Unit: 2612

discloses a similar system in which the reservation terminal is capable of converting reservation data into a form compatible with the EPG information. (Par. [0036]). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine both systems of Inagaki in order to provide a system capable of format conversion in order to enable multiple system formats to be utilized with the system, thereby user's are not required to make use of the same systems.

Claim 21 corresponds to the means plus function claim 10. Accordingly, it is analyzed and rejected as previously discussed.

Claim 15 recites the broadcasting receiving apparatus of claim 13, and further limitations too numerous to list herein. As discussed above, Inagaki contains all limitations of claim 13, but fails to specifically recite the limitations contained in claim 15. However, within the same field of endeavor, Inagaki '697 discloses a similar system in which the receiver is capable of converting the reservation data into a format compatible with the EPG. (Par. [0028]). (from this disclosure, it is inherent the receiver have a means capable of detecting whether the format of the storage medium corresponds to that of the EPG. If not, the receiver could not determine whether it needed to convert the format). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to further modify the combined systems of Inagaki in order to provide a system capable of converting stored reservation data from said removable medium into a format compatible with that of the receiver, thereby providing a apparatus capable of being utilized within multiple systems.

Claim 26 corresponds to the means plus function claim 15. Thus, it is analyzed and rejected as previously discussed.

4. Claims 14 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki '707 in view of Hassell et al. (UP Pat. Pub. No. 2004/0128685).

Claim 14 recites the broadcasting receiving apparatus of claim 13, and further limitations too numerous to list herein. As discussed above, Inagaki '707 contains all limitations of claim 13, but fails to specifically disclose the limitations recited in claim 14. However, within the same field of endeavor, Hassell discloses a similar system in which the receiver notifies the user when the reserved program is not contained on the EPG. (Par. [0089]). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Inagaki and Hassell in order to provide a system capable of notifying a user of the reserved program's unavailability, thereby providing a more user friendly system.

Claim 25 corresponds to the means plus function claim 14. Thus, it is analyzed and rejected as previously discussed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Terakado et al (US Pat. No. 6,246,441) disclose a system in which the remote is capable of displaying an EPG on an LCD screen. The remote also contains a slot for an IC card.

- b. Tsuria et al (US Pat. No. 6,424,947) disclose a system comprising a receiver and remote, each containing an IC card slot used to enable each to communicate with each via a wireless link.
- c. Redford et al (US Pat. No. 6,249,863) disclose a system comprising a remote capable of holding a removable storage media.
- d. Claassen (US Pat. No. 6,069,672) discloses a remote control comprising a slot for an IC card.
- e. Schultz et al (US Pat. No. 5,679,943) disclose a hand held terminal comprising, among other features, an LCD display.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Examiner's Initials _____

Application/Control Number: 09/808,133

Page 10

Art Unit: 2612

March 4, 2005.



NGOC-YEN YU
PRIMARY EXAMINER